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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		<u>09/816,820</u>	<u>03/22/01</u>
		First Named Inventor	
		<u>Hector Rodriquez</u>	
Art Unit		Examiner	
<u>2624</u>		<u>Douglas Q. Tran</u>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,520</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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SEPT. 20, 2005
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Douglas Q. Tran
Hector Rodriquez)	
)	Art Unit: 2624
Serial No.: 09/816,820)	
)	
Filed: 03/22/2001)	
)	
For: OUTPUT HANDLING OF PRINTED MEDIA)	
)	
Date of Final Office Action:)	Attorney Docket No.:
June 14, 2005)	10990200-1
)	
Date of Advisory Action:)	
August 23, 2005)	

September 20, 2005

**PRE-APPEAL BRIEF REQUEST FOR REVIEW and
ACCOMPANYING ARGUMENTS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests a Pre-Appeal Brief Review for the final rejection of the present application. The present request includes accompanying arguments and is being filed with a Notice of Appeal.

CERTIFICATE OF MAILING

Date of Deposit: **September 20, 2005**

I hereby certify that these papers are being deposited with the United States Postal Service with sufficient postage as "First Class Mail in an envelope addressed to: Mail Stop AF, The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Doreen Melchior
Doreen Melchior

Remarks

Applicants respectfully requests a Pre-Appeal Brief Review for the Final Rejection that was issued June 14, 2005. A Response After Final was filed on August 1, 2005 but no claims were amended. Reexamination and reconsideration of **claims 1-22** is respectfully requested.

Arguments for Review

Claims 1-3, 5, 7-19, and 21-22 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Miyamoto et al. (U.S. Pat. No. 4,591,884), in view of what is well known in the prior art.

Applicant respectfully submits that the rejection of record is clearly not proper and is without basis. There is a clear deficiency in the prima facie case in support of the rejection. In particular, Miyamoto teaches a paper flipping-mechanism that flips the side of a piece of paper, not the order of printed pages. For the reasons set forth below, the rejection is not supported by the teachings of Miyamoto in view of what is well known in the prior art and should be withdrawn.

The Present Claims Patentably Distinguish Over the References of Record

Independent Claim 1

The Office Action (dated June 14, 2005) states on page 2 that Miyamoto purportedly teaches a first accessory device with a reversing paper path (444 in Fig. 16) to reverse the order of the printed pages as recited in claim 1. The Office Action cites column 15, lines 30-49 of Miyamoto.

Miyamoto fails to teach or suggest the claimed feature because Miyamoto teaches that a sheet of paper is reversed, meaning flipped over, for two-sided recording and does not teach or suggest a reversing paper path to reverse the order of printed pages. Applicant

respectfully points out that reversing the order of printed pages is a different feature and a different functionality than flipping a page for two-sided printing. A paper path that reverses the order of printed pages, for example, is configured to re-order printed pages 3, 2, 1 to be in a reverse order of pages 1, 2, 3. An example is described on page 8, lines 7-19 of the present application.

Miyamoto is only concerned with flipping a sheet of paper, not reversing the order of printed pages. For example, attention is directed to Miyamoto in column 15, lines 41-42 where it describes that the paper "...is reversed in the first paper handling portion 420 and an image is formed on a second surface of the paper..."

Therefore, when Miyamoto discusses "reversing," it means flipping a piece of paper for two-sided recording. All references to "reversing" in Miyamoto discuss it as flipping a piece of paper. This has no relation to reversing the order of printed pages as recited in claim 1, is not directed to the same problem, and thus does not teach the claimed configuration of the reversing paper path. As such, Miyamoto fails to teach or suggest the features of claim 1 on which the rejection is based. Therefore, claim 1 patentably distinguishes over Miyamoto.

Additionally, the Office Action states that claim 1 is obvious over Miyamoto in view of what is well known in the prior art. In particular, the Office Action states that it would be a design choice and well known in the art to make the paper handling portion 420 of Miyamoto externally coupled to the printer. However, as stated previously, the paper handling portion 420 is not the claimed accessory device recited in claim 1. Therefore, Miyamoto fails to teach or suggest the claimed accessory device and thus using what is purportedly well known in the art fails to cure this shortcoming.

Applicant respectfully submits that an analysis of 35 USC §103 requires that evidence of a suggestion, teaching, or motivation to modify must be shown. In the present case, there is no evidence of record that teaches or suggests why the paper path of Miyamoto

would be modified to be an external accessory coupled to a printer and be configured to receive printed pages from the printer. Simply stating that such a modification is “well known in the art” or a “design choice” is not sufficient without a reference that suggests that the paper path of Miyamoto can be modified to be an external accessory. There is no such suggestion.

This modification, however, does not cure the shortcomings of Miyamoto since Miyamoto does not teach or suggest the claimed accessory with the straight-through paper path and reversing paper path as claimed.

Since claim 1 recites features not taught or suggested by Miyamoto, alone or in combination with other references, claim 1 patentably distinguishes over the references. Accordingly, dependent claims 2, 3, and 5-12 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 13

Independent claim 13 recites a reversing paper path to reverse the order of the printed pages received from the previous device. As previously explained, Miyamoto teaches a paper path that reverses or flips a piece of paper for two-sided recording. This is very different from a paper path that reverses the order of printed pages. As such, modifying Miyamoto with what is purportedly known in the art fails to cure the shortcomings of Miyamoto. Therefore, the rejection is not supported by Miyamoto and should be withdrawn. Claim 13 is now in condition for allowance.

Accordingly, dependent claims 14-17 also patentably distinguish over the references and are in condition for allowance.

Additionally, dependent claim 17 recites that the accessory device is configured to be coupled externally to a printing device and be configured as part of a chain of accessory devices that can be coupled together. Miyamoto fails to teach or suggest any such accessory since the printer components are internal to the printer and the components do not teach or

suggest the claimed accessory device. For this additional reason, claim 17 patentably distinguishes over Miyamoto.

Independent Claim 18

Claim 18 recites outputting the plurality of printed pages, in reverse order, from the printing device to a first accessory device and processing the received printed pages...where the first accessory device has a...reversing paper path to reverse the order of the printed pages.

As shown previously, paper handling portion 420 of Miyamoto does not reverse the order of printed pages. Therefore, Miyamoto fails to teach or suggest outputting printed pages in reverse order and a reversing paper path to reverse the order of the printed pages as recited in claim 18.


Therefore, Miyamoto, alone or in combination with other references, fails to teach or suggest the claimed features of claim 18 and claim 18 patentably distinguishes over Miyamoto. Accordingly, dependent claims 19-22 also patentably distinguish over the references and are in condition for allowance.

Conclusion

For the reasons set forth above, **claims 1-22** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

SEPT. 20, 2005



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